

REMARKS

Please reconsider the application in view of the above amendments and the following remarks.

Interview Summary

Applicants thank the Examiner for courtesies extended during the Examiner Interview conducted on October 4, 2007. In addition, Applicants have reviewed the Interview Summary issued on October 11, 2007, and agree with its contents.

Disposition of Claims

Claims 79-98 were pending in the referenced application. Claims 82 and 93-94 have been cancelled by this reply without prejudice or disclaimer. With respect to the pending claims, claim 79 is independent. The remaining claims depend, directly or indirectly, from independent claim 79.

Claim Amendments

Claims 79, 81, 83, 84, and 92 have been clarified by this reply. Support for the claim amendments to the aforementioned claims may be found, for example, on pages 41-47 of the application as filed. In addition, claims 80 and 85-90 have been amended to address antecedent basis issues resulting from the amendments made to independent claim 79. No new matter has been added by any of the aforementioned amendments.

Rejections under 35 U.S.C. § 103Claims 79-80, 90, and 98

Claims 79-80, 90, and 98 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,486,895 ("Robertson") in view of U.S. Patent No. 6,128,635 ("Ikeno"). Claim 75 has been cancelled by this reply. To the extent this rejection applies to the amended claims, the rejection is respectfully traversed.

Claim 79, as amended, is directed to a method for creating an electronic book. The method includes, in part, (i) obtaining pages of the electronic book (*i.e.*, electronic documents); (ii) organizing the pages in a first order; (iii) obtain an additional page (*i.e.*, the first additional electronic document), which includes a computer program configured to change the current order of the pages in the electronic book; (iv) executing the computer program to modify the order of the pages in the electronic book to obtain a new order of pages (*i.e.*, the second order); and (v) after the execution of the computer program the location of at least one page in the electronic book is different than its corresponding location prior to the execution of the computer program.

The following is an example used to illustrate one or more embodiments of the invention. The example is not intended to limit the scope of the claims. Turning to the example, consider a scenario in which the electronic book includes 5 pages denoted A-E and organized in the following order (*i.e.*, the first order) within the electronic book: A, B, C, D, E. At some later point in time a 6th page is obtained, page F (*i.e.*, the first additional electronic document). Page F includes a computer program configured to change the order of the pages in the electronic book. After executing the computer program in Page F, the order of the pages (*i.e.*, the second order) in the

electronic book is A, C, E, B, D. Further, Page F, which includes the computer program, may be subsequently added to the electronic book. (*see* Claim 80).

Turning to the rejection, to establish a *prima facie* case of obviousness "...the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP §2143.03. Further, "all words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP §2143.03. The Applicants respectfully assert that the references, when combined, fail to teach or suggest all the claim limitations of independent claim 79.

Specifically, the Examiner has admitted that Robertson fails to teach or suggest "wherein the first additional electronic document comprises a computer program configured to, when executed, modify the first hierarchy to obtain a second hierarchy; and rearranging the first plurality of documents within the book metaphor in accordance with the second hierarchy order, wherein the second hierarchy defines a location of each of the first plurality of electronic documents within the book metaphor"¹ (*See* Office Action mailed August 2, 2007, pp. 3-4). Further, Ikeno fails to teach or suggest that which Robertson lacks.

In particular, the Examiner characterizes the teachings of Ikeno as follows: "Ikeno teaches adding hyperlinked access to words in a document, when a dictionary mode button is activated" (*See* Office Action mailed August 2, 2007, p. 4). As discussed above, claim 79 has been clarified to recite that the order of the pages (*i.e.*, the plurality of electronic documents) in the electronic book is

¹ Applicants note that while the limitation "rearranging the first plurality of documents within the book metaphor in accordance with the second hierarchy order, wherein the second hierarchy defines a location of each of the first plurality of electronic documents within the book metaphor" was removed in the amendment to the claims, clarifying limitations, which include the subject matter of the aforementioned cancelled limitation were added to claim 79 by this reply. As such, the Examiner's statement regarding the teachings of Robertson is still applicable to amended claim 79.

modified such that at least one page is in a different location in the page after the order of the pages is modified. Applicants assert that the insertion of hyperlinks, as described in Ikeno, merely provide a mechanism for linking a word in a document to a dictionary application such that when the word is selected the corresponding electronic dictionary entry is retrieved and displayed to the user. *See* Ikeno, Abstract, FIG. 4, and FIG. 32. In view of the above, Ikeno does not teach or suggest modifying the order of the pages in an electronic book as recited by amended independent claim 79.

Accordingly, amended independent claim 79 is patentable over Robertson and Ikeno. Pending dependent claims are patentable over Robertson and Ikeno for at least the same reasons as amended independent claim 79.

Additionally, with respect to dependent claim 80, because Robertson does not disclose obtaining a page (*i.e.*, the first additional electronic document) that includes a computer program for modifying the order of the pages in an electronic book, it follows that Robertson does not teach or suggest adding such an electronic document to the electronic book. Moreover, Ikeno does not teach or suggest adding any pages to an electronic book. Accordingly, claim 80 is patentable over Robertson and Ikeno for at least this additional reason.

In view of the above, withdrawal of this rejection is respectfully requested.

Claims 81-89 and 91-97

Claims 81-89 and 91-97 stand rejected under 35 U.S.C. § 103(a) as being obvious over Robertson, Ikeno, and the article entitled “Laura Lemay’s Web Workshop Microsoft FrontPage 97” (“Lemay”). Claims 82 and 93-94 have been cancelled by this reply. Accordingly, this rejection is

now moot with respect to the cancelled claims. To the extent this rejection applies to the amended claims, the rejection is respectfully traversed.

Claims 81, 83-89, 91-92, and 95-97 depend from amended independent claims 79. As discussed above, neither Robertson nor Ikeno, whether considered separately or in combination, teach or suggest all the limitations of amended independent claim 79. Further, Lemay fails to teach or suggest that which Robertson and Ikeno lack. Specifically, Lemay discloses using web bots to monitor information on web pages and then, based on the monitoring, take action (e.g., regenerating a table of contents, recording the name of the author of the modification to a web page, and recording time stamp when last change was made to a web page). (See Office Action mailed August 2, 2007, p. 5-13, which describes Examiner's summary of the teachings of Lemay). Applicants assert that monitoring websites using web bots and then taking action based on the monitoring is not equivalent to obtaining an electronic document that includes a computer program configured to modifying the order of the pages in an electronic book and then executing the computer program to change the order of the pages in the electronic book. At most, Lemay teaches recording some information to indicate that the order has changed.

In view of the above, none of the cited prior art references, whether considered separately or in combination, teach or suggest all the limitations of amended independent claim 79. Thus, amended independent claim 79 is patentable over the cited prior art references. Pending dependent claims are patentable over the cited prior art for at least the same reasons as amended independent claim 79.

Additionally, with respect to dependent claims 81 and 83, none of the cited prior art references teaches or suggests: "wherein the usage information specifies a duration of time at least

one user viewed of the first plurality of electronic documents." Accordingly, claims 81 and 83 are patentable over cited prior art references for at least this additional reason.

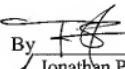
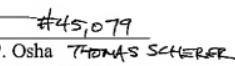
In view of the above, withdrawal of this rejection is respectfully requested.

Conclusion

Applicants believe this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 17363/002001).

Dated: November 2, 2007

Respectfully submitted,

 #45,079
By 
Jonathan P. Osha THOMAS SCHERER
Registration No.: 33,986
OSHA · LIANG LLP
1221 McKinney St., Suite 2800
Houston, Texas 77010
(713) 228-8600
(713) 228-8778 (Fax)
Attorney for Applicants

289503_2